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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/711,961	09/06/96	BRANSTROM	A 003/030/SAP

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HM11/0424

EXAMINER

RAILEY, J

ART UNIT

PAPER NUMBER

1636

DATE MAILED:

04/24/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/711,961

Applicant(s)
Branstrom et al.

Examiner
J. Railey

Group Art Unit
1636



☒ Responsive to communication(s) filed on 12 Jan 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-27, 34-43, and 45-55 is/are pending in the application.

Of the above, claim(s) 1-27 and 34-43 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 45-55 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1636.

Claims 1-27 and 34-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 6.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 45-55 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 53-57, 60, 62-67 and 70-74 of copending Application No. 08/523,855. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application claims methods for delivery of exogenous DNA capable of being expressed in an animal cell, while the copending application is drawn to similar methods for mammalian cells, as well as the delivery vehicles for

such methods. The claims in the instant application are obvious over the claims in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

All rejections under 35 U.S.C. §§ 102(e), 103(a) and 112, first and second paragraphs, as set forth in the previous office action, paper No. 9 have been withdrawn in view of applicant's response, paper No. 11, received 12 January 1998.

Figure 1 contains primer sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for these specific sequences for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Applicant is requested to return a copy of the attached Notice to Comply with the response to the instant office action. In addition, the specification or figure should be amended to include reference to the SEQ ID NOs. for these specific sequences found in Figure 1.

Applicant has noted that the *Shigella flexneri* clone 15D has been deposited at the ATCC under accession no. 55710. See the specification at page 12, line 7. Applicant has provided an averment regarding the availability of this deposit upon the granting of a patent on the instant

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Art Unit 1805

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application. However, the address of the depository is needed in the specification as filed, per the requirement as set forth in the previous office action, paper No. 7, mailed 29 April 1997. See the ATTACHMENT therein at the last paragraph. The current address of the ATCC is:

American Type Culture Collection
10801 University Boulevard
Manassas, VA 20110-2209.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Art Unit 1636 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number for Art Unit 1636 is (703) 308-4242 or 305-3014.

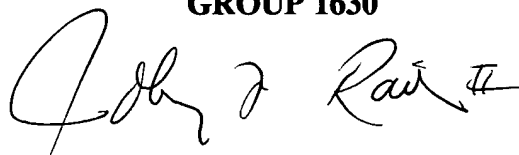
Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. F. Railey, whose telephone number is (703) 308-0281. The examiner can normally be reached on Monday-Thursday, and alternate Fridays, from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, can be reached at (703) 308-4003. The fax phone number for informal transmissions to the examiner is (703) 305-7939.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

23 April 1998

JOHNNY F. RAILEY II, PH.D.
PRIMARY EXAMINER
GROUP 1630

A handwritten signature in black ink, appearing to read "Johnny F. Railey II", is written over the printed name and title.